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08/876,937	06/16/1997	DAVID F. WOODWARD	16955DIVCONC	5537

7590 03/10/2005
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EXAMINER

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ART UNIT PAPER NUMBER

1621

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/876,937
Filing Date: June 16, 1997
Appellant(s): WOODWARD ET AL.

Robert J. Baran
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 July 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claim 26, 27, 29-35 and 37- 45.

Claims 46-48 are allowed but subject to interference.

Claims 1-25, 28 and 36 have been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

Appellant's brief includes a statement that claims 26 through 45 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,510,383

Bishop et al.

4-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26, 27, 29-35 and 37- 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Bishop et al., US '383, who disclose the narrow generic formula I as well as the isopropyl esters of Cloprostenol and Fluprostenol as compounds A and B of Table 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 27, 29-35 and 37- 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop et al., US '383. Bishop et al. disclose the compounds of formula I to be useful in treating glaucoma and ocular hypertension. In said formula, R1 may be hydrogen, a cationic salt moiety, a pharmaceutically acceptable amine moiety or C1-C12 alkyl, cycloalkyl or aryl and R2 may be chloro or trifluoromethyl (s. Col. 3, l. 35 – Col. 4., l. 16). Specific compounds are disclosed in table I, with administration to monkeys shown in example 2. The instant invention differs from the teaching of Bishop et al. in that, although generically disclosed, not all of the compounds are specifically exemplified. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of Bishop et al., to make other claimed compounds especially in view of the close or overlapping compounds already made by Bishop et al. and to expect them to be useful in the treatment of glaucoma and ocular hypertension.

(11) Response to Argument

Although the oldest grandparent in the instant series of applications, Woodward et al., U.S.S.N. 07/948,056, now US 5,353,708, has a filing date before Bishop et al., US '383, filed 3 August 1993, the disclosure of Woodward et al. '056, is narrower than that of the instant claims. Appellants filed a granddaughter continuation-in-part application, U.S.S.N. 08/371,339, on 11 January 1995, now US 5,688,819, and the instant application, 08/876,937, is a granddaughter application of said continuation-in-part. Woodward et al. '056 discloses that : " X may be selected from the group consisting of

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-H, -F, -I, -NO₂, -OH, -OH (sic), -C(O)N(R₄)(R₄), -N(R₄)(R₄), =N-OH, -C(triple bond)N, -SH, -SR₅ and -OR₅ wherein R₄ is hydrogen or C1-C3 alkyl," (Col. 6., ll. 42-51).

Woodward et al. additionally discloses the methyl ester and the amide derivatives of Cloprostenol in examples 8 and 9 and has provided a declaration showing the use of the Fluprostenol and its amide derivative before the filing date of Bishop et al. '383.

Appellants' generic claims, copied from Bishop et al., '383, claim compounds wherein C(O)₂R₁ (corresponding to the X of Woodward et al. '056) is acid, an acid salt with a cationic salt moiety, or a lower alkyl ester. Appellants claims are thus broader than the support shown in Woodward et al. '056 and Bishop et al. '383 is still prior art to that part of the claims broader than the disclosure of Woodward et al. '056.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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March 6, 2005

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A handwritten signature in black ink, appearing to read 'Elvis O. Price', with a stylized, cursive script.

Elvis O. Price

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